

### **REMARKS/ARGUMENTS**

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

### **STATUS OF THE CLAIMS**

Claims 1-11 are pending; Claims 7-11 are newly added herewith; and no claims are canceled. It is respectfully submitted that no new matter is added by this amendment.

### **SUMMARY OF THE OFFICE ACTION**

In the outstanding Office Action, Claims 1, 2, and 4-6 were rejected under 35 U.S.C. § 102(e) as unpatentable over Matsui et al. (U.S. Pat. No. 6,674,995, hereafter Matsui); and Claim 3 was rejected under 35 U.S.C. § 103(a) as unpatentable over Matsui.

### **REJECTION UNDER 35 U.S.C. § 102**

With regard to the outstanding rejection of Claims 1, 2, and 4-6 under 35 U.S.C. § 102(e) as unpatentable over Matsui, that rejection is respectfully traversed.

Claim 1 recites, in part:

first setting means for setting whether or not a data format of the image information determined as an object of copying by the moving means should be converted based on the user input  
...

conversion means for converting the data format of the image information read out by said readout means based on the setting of said first setting means ...

Claims 5 and 6 recite analogous features.

The outstanding Office Action asserts at page 2 that Matsui describes converting files to different file types based on user selection. To support this assertion, the outstanding Office Action cites to col. 27, lines 20-35 of Matsui.

Matsui describes at the cited portion that there are three display formats for clip cards 179 as shown in Figures 15a-15c. Matsui further describes that each of these clip cards includes different information, such as a clip name, a stamp picture at an in-point, and a duration of an event. Matsui describes that the editing operator selects a desired format from the three clip card display formats and stores an event as a clip card on the log window 93.

As this description indicates, the “format” of the clip cards in Matsui does not relate to JPEG or GIF, but rather relates to how the picture appears on a display screen. In fact, Matsui does not address file format types (such as JPEG, GIF, or MPEG) at all. Thus, it is respectfully submitted that there is no basis for the statement in the outstanding Office Action that “the conversion of the present file type to a different file type (i.e., JPEG could be saved as a GIF) and thereby would convert the data through user selection and thereby meeting the limitation.”

Consequently, as Matsui fails to disclose or suggest the features of Claim 1, from which Claims 2-4 depend, it is respectfully submitted that Claims 1-4 patentably distinguish over Matsui. Likewise, because independent Claims 5 and 6 recite analogous features, it is respectfully submitted that these claims also patentably distinguish over Matsui.

#### REJECTION UNDER 35 U.S.C. § 103

With regard to the rejection of Claim 3 under 35 U.S.C. § 103(a) as unpatentable over Matsui, this rejection is also respectfully traversed. Matsui is assigned on its face to Sony Corporation. As noted in the Office Action, Matsui is only available against the pending claims under 35 U.S.C. § 102(e). The inventors of the above-identified application were under an obligation to assign the subject matter of the present invention to Sony Corporation at the time of invention. Evidence of this obligation is set forth in the assignment to Sony Corporation, which is recorded at reel 011778/frame 0524.

Accordingly, as Matsui is only available against the pending claims under 35 U.S.C. § 102(e) and is commonly assigned to Sony Corporation, it is respectfully submitted that Matsui may not be applied against the pending claims under 35 U.S.C. § 103. It is therefore respectfully requested that this rejection be withdrawn.

#### NEW CLAIMS

Support for newly added Claims 7-11 may be found in the specification at least, for example, at page 16. It is therefore respectfully submitted that no new matter is added by Claims 7-11. Newly added Claims 7-11 also recite features not disclosed or suggested by Matsui, and are believed to be in condition for allowance.

#### CONCLUSION

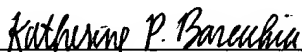
Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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